

Amendments to the Drawings:

The attached replacement drawing sheet makes changes to Fig. 2 and replaces the original sheet with Fig. 2.

Attachment: Replacement Sheet

REMARKS

Claims 2, 8, 10, and 13-20 are pending in this application. By this Amendment, Figure 2 is amended to correct typographical errors. Specifically, Figure 2 is amended to recite the electric conductivity of Example 1 as 29.0 $\mu\text{S/cm}$ instead of 290 $\mu\text{S/cm}$ and to properly identify the columns listing the data for Comparative Examples 2–6. Support for the amendments may be found, for example, at page 14, first paragraph of the substitute specification, and Figure 1. No new matter is added.

In view of the following remarks, reconsideration and allowance are respectfully requested.

I. Telephone Interview

The courtesies extended to Applicant's representative by Examiner Hardee during the telephone interview held June 27, 2007 are appreciated. The reasons presented during the interview as warranting favorable action are incorporated into the remarks below and constitute Applicant's record of the interview.

II. Rejections under 35 U.S.C. §112, First Paragraph

A. Written Description

The Office Action rejects claims 2, 8, 10, 13, 14, and 16 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action states the original disclosure lacks support for phosphonic acid. However, as agreed to during the June 27 telephone interview with Examiner Hardee, the Certification of English Language Translation submitted on May 18, 2007 overcomes this rejection. Accordingly, withdrawal of the rejection is respectfully requested.

B. Enablement

The Office Action rejects claims 2, 8, 10, 13, 14, and 16 under the enablement requirement of 35 U.S.C. §112, first paragraph. Specifically, the Office Action asserts that

Example 1, which contains orthophosphoric acid at the minimum recited concentration, does not meet the recited conductivity criterion. *See* Office Action, page 3. Applicant respectfully traverses the rejection.

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). In order to make an enablement rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided by the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). As stated by the court:

It is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosures.

In the instant Office Action rejection, the Office Action fails to establish a reasonable basis to question the enablement provided. More precisely, the Office Action fails to specifically explain why any doubts exist regarding the truth or accuracy of the specification, which discloses that the electric conductivity of Example 1 is 29.0 $\mu\text{S}/\text{cm}$ (*see* substitute specification at page 14, first paragraph). Therefore, Applicant respectfully requests clarification as to why this presumptively accurate disclosure is questioned, and if this cannot be provided, that the rejection be withdrawn.

III. Rejection Under 35 U.S.C. §103

The Office Action rejects claims 2, 8, 10, 13, 14, and 16 under 35 U.S.C. §103(a) over JP Application No. 52-106116 ("Goto"). Applicants respectfully traverse the rejection.

Claim 2 specifically requires an acidic additive that "comprises at least one of a orthophosphoric acid, at a concentration ranging from 0.1% to 1.0% and phosphonic acid at a concentration ranging from 0.001% to 0.01%; and wherein coolant has an electric conductivity equal to or less than 100 μ S/cm" (emphasis added). Despite its asserted disclosures, Goto does not disclose such features.

Goto does not teach or suggest the use of phosphonic acid or orthophosphoric acid. Nor does Goto teach or suggest conductivity equal to or less than 100 μ S/cm as recited by claim 2. Therefore, because Goto fails to teach or suggest each and every feature of claim 2, Goto would not have rendered obvious the subject matter of claim 2.

Goto would not have rendered obvious claim 2. Claims 8, 10, 13, 14, and 16 variously depend from claim 2 and, thus, also would not have been rendered obvious by Goto. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:JRB/kxs

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